

REMARKS

Claims 1-14 and 16-43 are pending. In the Office Action, the Examiner rejected claims 1-14 and 16-43 under 35 U.S.C. §101 by arguing that the invention does not show a physical transformation or a tangible result. Claims 1, 5, 8-14, 16, 18-22, 24-33, 35-39 and 41-43 have also been rejected as being unpatentable pursuant to 35 U.S.C. §103(a) over MacFarlane et al. (US 5,311,293) in view of Fabbri et al. (US 4,561,850). The remaining claims have been rejected as being unpatentable pursuant to 35 U.S.C. §103(a) over MacFarlane et al., in view of Fabbri et al., and in further view of either Nakamura (US 4,987,552), Rifkin (US 6,065,969) or Thies (US 5,206,804).

Applicant respectfully disagrees with the Examiner's rejections and, accordingly, requests the reconsideration and withdrawal of those rejections.

Regarding 35 U.S.C. §101

Applicant respectfully disagrees with the Examiner's rejection of the claims pursuant to 35 U.S.C. §101. The step, for example, in claim 1 of "identifying for the individual complimentary fashion selections that are appropriate for the individual based upon the physical characteristic data received in the personal characteristic database" is a useful, concrete and tangible result. Therefore, this rejection should be withdrawn.

Although unstated, the Examiner has doubtless based the §101 rejection on the 2005 Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility. Those guidelines, however, must be read in the light of the controlling decisions of the Federal Circuit. Specifically, in *State Street Bank v. Signature Financial Group, Inc.*, 47 USPQ 2d 1596 (CAFC 1998), the court upheld the fact that a business process patent may be granted on the same basis as any other invention. The court further confirmed this principle with *AT&T*

Corporation v. Excel Communications, Inc., 50 USPQ 2d 1447 (Fed. Cir. 1999). These two cases eliminated the business process exception from the US patent common law. These decisions also explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601. However, the “tangible” requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. See Guidelines at 21. Rather, the tangible result requirement as best understood was stating that the claims should not be directed to an abstract idea. *Id.* at 22.

Here, the process (method) outlined in the claims does produce a useful, concrete and tangible result. Specifically, step of “identifying for the individual complimentary fashion selections that are appropriate for the individual based upon the physical characteristic data received in the personal characteristic database”. The identification of these fashion selections, based upon defined input data, is clearly a useful and concrete and tangible result. Indeed, such a result is, at the very least, on par with the result provided by the patent at issue in *State Street* (i.e., the generation of a final share price).

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection pursuant to 35 U.S.C. §101.

Regarding 35 U.S.C. §103(a)

Applicant respectfully disagrees with the Examiner’s rejections of the claims pursuant to 35 U.S.C. §103(a) for the reason that MacFarlane et al. clearly teaches away from the present invention and, therefore, it is not properly combinable with Fabbri et al., or any other reference that would seek to use multiple factors to identify complementary fashion selections.

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. *See In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The Federal Circuit has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. *See*, e.g., *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to

combine the relevant teachings of the references.”” *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”” *In re Dembicza*k, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” *Dembicza*k, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). Further, as pointed out by the Federal Circuit, one must first determine the scope of the claim. “[T]he name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations of independent claim 8.

In this case, Applicant very respectfully submits that the Examiner’s conclusion regarding MacFarlane et al. is incorrect and, as a result, the Examiner has engaged hindsight reconstruction. Specifically, in the Response to Arguments section of the Office Action (page 9), the Examiner asserted that “[a]lthough MacFarlane bases the determination on one characteristic, it does not expressly disqualify the use of other attributes.” However, since MacFarlane does clearly rely on skin color as the sole and exclusive basis for determining other color attributes, the Examiner’s conclusion was incorrect.

For example, at Col. 2, lines 29-37, MacFarlane et al. stated that skin color was the exclusive means for determining color assessment:

Recognition of skin color **exclusively** as the determinative factor in arriving at personal color categorization, then the further recognition of the blue and yellow undertones as the controlling characteristic, to the exclusion of other color measurements, contrary to the popular techniques and writings, were significant

steps toward the establishment of a scientifically sound and readily reproducible personal color assessment method.

Further, at Col 1, lines 18-20, MacFarlane et al. stated that the disclosed invention related to a method for identifying skin color:

This invention relates to a method and instrument for identifying categories of skin coloration for compatibility with colors of clothing, makeup, etc.

Finally, at Col. 1, lines 30-33, MacFarlane et al. stated it would be wrong to use other methods to determine colors for clothing, etc.

Recently, numerous proposals for identifying colors of, for example, clothing, makeup, hair colorants, and the like, based upon an individual person's coloration have been put forth. Some of these proposed techniques have taken into account the color of the person's complexion, but have incorrectly emphasized redness and have also *wrongly relied upon eye color, color of hair, and even racial background to assign color categories to the person*. Based on that assignment a preselected collection of colors of fabric or other materials was chosen.

Based on the above, one of skill in the art would not look to MacFarlane et al., alone or in combination with other references, as teaching devices/processes that use multiple factors to identify complementary fashion selections since MacFarlane et al. limited itself to the measurement of skin color as the exclusive means for determining other color selections.

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Therefore, in view of the above amendments and remarks, Applicant submits that the application is now in proper form for allowance. Such action is respectfully requested.

Respectfully submitted,



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